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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,362	11/10/2000	John C. Connolly	PLW 13206	5398

28581

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CHICAGO, IL 60606

EXAMINER
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MENEFEE, JAMES A

ART UNIT	PAPER NUMBER
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2828

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/710,362

Applicant(s)

CONNOLLY ET AL.

Examiner

James A. Menefee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

  
Paul Ip  
Primary Examiner

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of claims 1-11 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there are only 23 claims, which is not an undue number, and therefore separate status for search does not provide proper basis for restriction. This is not found persuasive. The fact that the claims are not "unduly multiplied" as stated by the applicant is not related to the requirements for restriction. The following is shown in MPEP 803:

*There are two criteria for a proper requirement for restriction between patentably distinct inventions:*

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and*
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).*

In this case, the inventions have been shown to be independent and distinct as they are a process of making and a product made. The inventions have acquired a separate status in the art as shown by classification in different classes, and thus a proper search of the second invention would require searching of additional classes. This is deemed a serious burden.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Objections***

Claim 2 is objected to because of the following informalities: The term "wells" in line 2 should read -well-. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-8 and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagai (US 5,960,020). Nagai discloses the claimed invention as follows:

Regarding claim 1, Nagai discloses a ridge waveguide semiconductor laser diode comprising a first conductor layer 14, a second conductor layer 15 facing the first conductor layer, an active layer 3 disposed between the conductor layers, a gain region of the active layer (circled in red below), and reduced conductivity regions 7 of the

Regarding claim 5, while Nagai does not explicitly state the material of the active layer, all of the other parts of the laser are made of materials such as AlGaAs and GaAs, therefore it is inherent that the active layer may be made of one of the claimed materials.

Regarding claim 6, it is inherent that the conductor layers provide a current through the active layer larger than the threshold current because this will necessarily happen for lasing to occur.

Regarding claim 7, it has been disclosed in the rejection of claims 3-4 above that the desired lateral modes are sustained. It is also disclosed that the amplification portion of the gain region has a smaller lateral extent than the entire gain region (abstract lines 9-13).

Regarding claim 8, Nagai discloses that the reduced conductivity regions 7 are implanted with high energy Si ions (Fig. 2B and discussion thereof).

Regarding claim 10, it is inherent that the reduced conductivity portions provide a lateral index step, because these portions will necessarily have a different refractive index than the gain region because light is being guided through the gain region.

Regarding claim 11, an insulator 12 is disposed adjacent to the first conductor layer (see Fig. 1 above).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagai in view of Nagai et al (US 5,469,457). Nagai '020 discloses all of the limitations of the

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claims as shown above, but does not disclose the specific energy of the high energy implanted ions. Nagai '457 teaches a device where Si ions (as in Nagai '020 above) are implanted for the same reason as in Nagai '020, to produce disordered regions where little current flows. Nagai '457 teaches that these ions be implanted at an energy of 150 KeV (col. 9 lines 20-36). It would have been obvious to one skilled in the art to implant the atoms at that energy as the atoms will be sufficient for disordering the quantum wells, and so the upper cladding will not be converted to the same conductivity as the lower cladding, as taught by Nagai '457.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Menefee whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Paul Ip  
Primary Examiner

JM  
March 6, 2002